



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,771	01/22/2002	Bruce Loring Brown JR.	03399P074	6248

26529 7590 03/11/2005

BLAKELY SOKOLOFF TAYLOR & ZAFMAN/PDC
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

MARTIN, NICHOLAS A

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,771

Applicant(s)

BROWN ET AL.

Examiner

Nicholas Martin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/9/004</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2154

1. Claims 1-42 are presented for examination.

Claim Objections

2. Claims 34 and 42 are objected to because of the following informalities:
3. There is an error in claim 34 where it states, "The client device of claim 30,". Being that claim 30 is not a client device but a server system, for the remainder of the prosecution, claim 34 will be regarded as claiming dependency to the client device of claim 33.
4. There is a typographical error in claim 42 where it states, "...Internet Message Access Protocol (IMPAP)." It is assumed that it should state "(IMAP)" and will be regarded as so for the remainder of the prosecution.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 8-10, 13-17, 20-22, 25-29, 32-34 and 37-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Reed et al. (hereinafter Reed), US 6,004,205.

Art Unit: 2154

7. As per claim 1, Reed teaches a method for operating an electronic mail server system having mailboxes associated with message client devices (Col. 20, lines 65-67; Col. 21, lines 1-5), the method comprising:

receiving input to change a mailbox, said input comprising a request to change an organizational structure of said mailbox (Col. 5, lines 5-17; Col. 29, lines 36-38; Col. 43, lines 29-40, lines 44-47; Col. 44, lines 14-17);

making changes to said mailbox in response to said input (Col. 5, lines 5-19; Col. 29, lines 36-38; Col. 43, lines 29-40, lines 44-47; Col. 44, lines 14-17); and

sending a message to a message client device associated with said mailbox, said message comprising information to allow said message client device to synchronize a cached version of said mailbox stored locally in said message client device with said mailbox (Col. 5, lines 6-19; Col. 12, lines 16-17; Col. 29, lines 36-38; Col. 37, lines 2-6; Col. 39, lines 10-45).

8. As per claim 2, Reed teaches the method of claim 1, wherein said input further comprises a new mail message (Col. 10, lines 29-34; Col. 21, lines 1-5; Col. 31, lines 45-50; Col. 32, lines 23-28).

9. As per claim 3, Reed teaches the method of claim 1, further comprising checking whether said message client device is subscribed to receive said message; and sending said message only if said message client device is so subscribed (Col. 27, lines 42-46; Col. 28, lines 10-28).

10. As per claim 4, Reed teaches the method of claim 1, wherein said information comprises information to update mail folders (Col. 20, lines 54-64; Col. 42, lines 18-29).

Art Unit: 2154

11. As per claim 5, Reed teaches the method of claim 2, wherein said information comprises parameters required by a message access protocol to allow said message client device to retrieve said new mail message (Col. 20, lines 54-64; Col. 21, lines 1-5).

12. As per claim 8, Reed teaches the method of claim 4, wherein said information to update said mail folders comprises a request selected from a group comprising a request to add, remove, rename folders in said cached version of said mailbox (Col. 21, lines 34-42; Col. 23, lines 39-49; Col. 29, lines 29-34).

13. As per claim 9, Reed teaches a method for operating a message client device, said method comprising:

receiving a client message (Col. 37, lines 33-36);

checking whether said client message is a mail notification message (Col. 36, lines 42-49, lines 51-53; Col. 37, lines 36-40); and

if said client message is a mail notification message, then decoding said message to obtain message access protocol parameters; connecting to a mail server and synchronizing a cached mailbox stored locally in said message client device with an associated mailbox stored in said mail server using said message access protocol parameters, wherein said synchronizing comprises retrieving changes to an organizational structure of said associated mailbox and updating said cached mailbox in response; and notifying a user of said message client device of new mail messages received during said synchronization (Col. 8, lines 38-43; Col. 20, lines 51-64; Col. 21, lines 1-5; Col. 37, lines 36-40; Col. 39, lines 10-45; Col. 43, lines 1-15).

Art Unit: 2154

14. As per claim 10, Reed teaches the method of claim 9, wherein said synchronizing further comprises retrieving new mail; and storing said new mail in said cached mailbox (Col. 20, lines 54-64).

15. Claims 13-17 do not teach or define any new limitations above claims 1-5 and therefore are rejected for similar reasons.

16. Claim 20 does not teach or define any new limitations above claim 8 and therefore is rejected for similar reasons.

17. Claims 21-22 do not teach or define any new limitations above claims 9-10 and therefore are rejected for similar reasons.

18. Claims 25-29 do not teach or define any new limitations above claims 1-5 and therefore are rejected for similar reasons.

19. Claim 32 does not teach or define any new limitations above claim 8, and therefore is rejected for similar reasons.

20. Claims 33-34 do not teach or define any new limitations above claims 9-10 and therefore are rejected for similar reasons.

21. Claims 37-39 do not teach or define any new limitations above claims 1-3 and therefore are rejected for similar reasons.

22. Claims 40-41 do not teach or define any new limitations above claims 9-10 and therefore are rejected for similar reasons.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 6-7, 11-12, 18-19, 23-24, 30-31, 35-36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed in view of Witteman, Bradley James (hereinafter Witteman), US 2002/0055950.

25. As per claim 6, Reed does not explicitly teach the method of claim 5, wherein said message access protocol comprises the Internet Message Access Protocol (IMAP).

26. Witteman teaches a method of claim 5, wherein said message access protocol comprises the Internet Message Access Protocol (IMAP) (Paragraph [0091]).

27. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Witteman and Reed because they both deal with the transmission and synchronization of information utilizing electronic mail.

Furthermore, the teachings of Witteman to allow wherein said message access protocol comprises the Internet Message Access Protocol (IMAP) would improve the functionality of Reed's system by increasing efficiency by allowing clients to retrieve messages from more than one computer at a time.

28. As per claim 7, Reed does not explicitly teach the method of claim 1, wherein said message is sent using a Short Message Service (SMS).

Art Unit: 2154

29. Witteman teaches a method of claim 1; wherein said message is sent using a Short Message Service (SMS) (Paragraphs [0062], [0096] and [0100]).

30. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Witteman and Reed because they both deal with the transmission and synchronization of information utilizing electronic mail.

Furthermore, the teachings of Witteman to allow wherein said message is sent using a Short Message Service (SMS) would improve the functionality of Reed's system by increasing flexibility of messaging services through more widespread integration with other data access applications and increasing efficiency through the delivery of messages to multiple clients at a time.

31. Claims 11-12 do not teach or define any new limitations above claims 6-7 and therefore are rejected for similar reasons.

32. Claims 18-19 do not teach or define any new limitations above claims 6-7 and therefore are rejected for similar reasons.

33. Claims 23-24 do not teach or define any new limitations above claims 6-7 and therefore are rejected for similar reasons.

34. Claims 30-31 do not teach or define any new limitations above claims 6-7 and therefore are rejected for similar reasons.

35. Claims 35-36 do not teach or define any new limitations above claims 6-7 and therefore are rejected for similar reasons.

Art Unit: 2154

36. Claim 42 does not teach or define any new limitations above claim 6 and therefore is rejected for similar reasons.

Conclusion

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Electronic Mail Retrieval".

- | | | |
|------|-----------------|-----------------|
| i. | US 2003/0131073 | Lucovsky et al. |
| ii. | US 6,658,485 | Baber et al. |
| iii. | US 2003/0187938 | Mousseau et al. |

A shortened statutory period for reply to this Office action is set to expire in THREE MONTHS from the mailing date of this action.

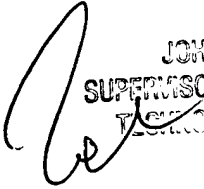
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Martin whose telephone number is (571) 272-3970. The examiner can normally be reached on Monday - Friday 8:30 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3970.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

nam
February 25, 2005


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100